

REMARKS

This application has been carefully reviewed in light of the Office Action dated May 21, 2004. Claims 45 to 61 are in the application, of which Claims 45 and 58 are still the only independent claims. Reconsideration and further examination are respectfully requested.

A further revision to the Abstract has been provided, to match more closely to the subject matter of Claims 45 to 61.

The informalities noted in Claims 46, 47, 57 and 61 have been attended to by amendment. To the extent that others of the pending claims have language similar to that found objectionable, the language of the other claims has been amended as well.

The aforementioned amendments are the only amendments made herein. Entry is therefore proper, since the amendments attend to formalities only and were specifically requested by the Examiner.

Claims 45, 47, 50, 52 to 54, 56 to 58, 60 and 61 were rejected under 35 U.S.C. § 102(b) over European 1,013,445 (Miyazaki), and Claims 45, 46 and 50 were further rejected under § 102(b) over Japan 5-96744 (Kataoka). The rejections are respectfully traversed.

The invention relates to a liquid container which includes structure that facilitates distribution of components of ink contained therein, even if the liquid container remains motionless for prolonged periods. Such a situation is common in off-carriage types of liquid containers, for the reason that these containers do not move during use. According to one feature of the invention, a connecting portion is provided to which an ink deriving tube and an air introducing tube are connected and which are deviated to one of side walls with respect to a center portion of a bottom surface of a container main body. As defined in independent Claims 45 and 58, the bottom surface is "a bottom surface of

said container main body in a mounted state thereof on the mounting portion" of an ink jet printer.

Miyazaki is silent about any connection portion provided at a bottom surface of its ink container main body. Rather, Miyazaki discloses that its connecting portion is provided at an uppermost surface.

Likewise, Kataoka is silent about a connecting portion being provided at a bottom surface. As shown in Figure 5 of Kataoka, the connecting portion is provided at its side surface. In this regard, the reproduction at page 5 of the Office Action of Kataoka's Figure 5, in which the figure has been rotated so that Kataoka's sideways-facing connecting portion is shown as facing downwardly, is believed to be an unfair distortion of the prior art and contrary to the interpretation that one of ordinary skill would give to Figure 5.

In entering the rejections over Miyazaki and Kataoka, the Office Action cited to *Ex parte Masham* in support of its disregard of the claimed invention's definition of "bottom surface". According to the Office Action, the definition of "bottom surface" does not differentiate the claimed liquid container in terms of structure. Applicants respectfully disagree.

First, although it is true as confirmed by *Masham* that a claimed apparatus must differentiate from prior art in terms of structure, it is respectfully submitted that the claimed "bottom surface" indeed is structure. The claims herein specify that the bottom surface is a "bottom surface of said container main body in a mounted state thereof on the mounting portion", and thus defines a specific one of the surfaces of the container. It is not understood how such a surface is not "structure".

Second, *Masham* was decided based on claims that specified a mixing means that was "completely submerged" in a developer material, but the developer material itself was not part of the claim. Thus, *Masham*'s claims are factually different

from the claims herein since the claims herein specify a "bottom surface" that is part of the claimed apparatus whereas the "developer material" of Masham was not.

Third, *Masham* was decided based on the Examiner's finding that the prior art device was capable of operating exactly the same as the claimed apparatus. No such allegation has been made here. Indeed, the distortions of Kataoka's Figure 5 (on page 5 of the Office Action) underscore that such an allegation could not be made, since it would result in an impossible sideways movement of bubbles 7. Likewise, given the construction of Miyazaki's ink tank, it is not believed that the ink tank would work as intended if turned upside-down.

In similar factual circumstances where the PTO Board sustained a rejection of claims based on art which it turned upside-down, the Federal Circuit reversed. See *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984). Although *Gordon* involved a rejection under § 103 and not under § 102, the Federal Circuit was convinced that the prior art could not be modified by turning it upside-down particularly since it would be rendered inoperable for its intended purposes if oriented in the upside-down position.

Anticipation under § 102 is a strict word-for-word identity test in which a single prior art reference must show, with word-for-word identity, every element of the invention, with all of those elements arranged exactly as in the claim. "For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference." *In re Bond*, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990) (quoting *Diversitech v. Century Steps*, 7 USPQ2d 1315).

Here, the claims specifically define the bottom surface a "bottom surface of said container main body in a mounted state thereof on the mounting portion". Such a surface is clearly structural, and is different from the upper surface of Miyazaki and the side surface of Kataoka. As such, it cannot be said that Miyazaki or Kataoka show every element of the claimed invention "identically", as is required for a rejection under § 102. Withdrawal of the § 102 rejections is therefore respectfully requested.

The remaining claims were rejected under § 103(a) over Miyazaki or Kataoka further in view of secondary references to U.S. Patent 6,585,359 (Gasvoda), U.S. Patent 6,644,778 (Rotering), or U.S. Patent 3,708,798 (Hildenbrand). These rejections are all traversed. In particular, none of the cited art shows a "bottom surface" constructed as set out in the claims. Moreover, with respect to these § 103 rejections, the Federal Circuit's holding in *In re Gordon* is directly applicable such that the rejections under § 103 are contrary to law.

Withdrawal of the § 103(a) rejections is respectfully requested.

Turning to a formal matter involving Information Disclosure Statements, it is respectfully requested that the next Office Action indicate consideration of art cited in the Information Disclosure Statement dated June 2, 2004.

Applicants' undersigned attorney may be reached in our Costa Mesa, California office by telephone at (714) 540-8700. All correspondence should continue to be directed to our address given below.

Respectfully submitted,



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